

REMARKS

The claims have been amended to define R¹ to be 1,3-dihydroxyprop-2-yl and to delete the other definitions for R¹. Species claim 25 has been amended accordingly and new claim 32 is directed to the last species found in original claim 25. There being no new matter, entry is respectfully requested.

Claims 1-16 and 21-32 are pending in this application. Claims 17-20 have been cancelled; Claims 28-31 have been withdrawn by the Examiner and Claim 32 has been added.

In sections 1 to 3 of the Office Action, the Examiner acknowledges Applicants' election with traverse of Group I (claims 1-27) with Example 2 at page 15 as the elected species and makes the restriction requirement final. The Examiner argues that a search of group II (claims 28-31) with respect to treating diseases is not required for the search of group I. Applicants point out that the classification provided for both groups is the same, i.e. Class 514, Subclass 315, and therefore submit that there would not be any undue examination burden to search both groups at the same time. Moreover, as specifically pointed out at page 2 of the previous response, even if the Examiner maintains this restriction requirement, Applicants submit that the USPTO's Rejoinder Practice found at MPEP 821.04 would require that the method claims of Group II be rejoined with the examination of the compound claims of Group I in the event that the compound claims are determined to be patentable, since the method claims depend from the compound claims. Accordingly, rejoinder of Group II is respectfully requested in the event that this restriction requirement is maintained.

In view of the above, withdrawal of the restriction requirement is respectfully requested or, in the alternative, rejoinder of the method claims of Group II with the examination of the compound claims of Group I if the compound claims are found to be patentable.

In sections 4 to 5 of the Office Action, claims 1-16 and 21-27 are rejected under 35 USC 103(a) as being unpatentable over WO 97/32865. In the statement of the rejection the Examiner argues that the compounds of the instant claims where R¹ is 3-hydroxypropyl or C₅-cycloalkylmethyl and R² is hydrogen, methyl or 2-hydroxyethyl are structural homologs of the reference compounds and therefore obvious. The claims have now been amended to delete compounds wherein R¹ is either 3-hydroxypropyl or C₃-C₆ cycloalkylmethyl, thus avoiding the issue raised by the Examiner. The compounds of the present invention wherein R¹ is defined to be 1,3-dihydroxyprop-2-yl are not disclosed or suggested by the cited reference. Applicants submit that there is nothing in the cited reference that would have motivated one skilled in the art to structurally modify the disclosed compounds in the manner necessary in order to arrive at the presently claimed compounds, let alone with a reasonable expectation of success. Applicants therefore submit that the cited reference fails to establish a *prima facie* case of obviousness against the presently claimed invention.

As to claim 26 (process of making) and claim 27 (pharmaceutical composition), Applicants point out that as the cited reference fails to render obvious the compounds of claim 1, it cannot render obvious the process of making a compound of claim 1 (as in claim 26) or a composition comprising a compound of claim 1 (as in claim 27).

Withdrawal of this rejection of claims 1-16 and 21-27 is therefore respectfully requested.

It is believed by applicants' attorney that the pending claims are in condition for allowance and early notification thereof is respectfully requested.

Respectfully submitted,




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AMENDMENT

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